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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,864	12/11/2001	Michael J. Tari	ICOR-004	3644

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PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
FOUR TIMES SQUARE
NEW YORK, NY 10036

EXAMINER

GREIMEL, JOCELYN

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/014,864

Applicant(s)

TARI ET AL.

Examiner

Jocelyn Greimel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's Amendments and Remarks filed 29 January 2007.

Status of Claims

2. Claims 1-14 are currently pending. Claims 1-2, 5-8 and 10-14 are currently amended. Claims 1, 8, 12 and 14 are independent claims.

Response to Arguments

3. The Oath and Declaration and the subsequent Decision According Status Under 37 C.F.R. 1.47(a) have been fully considered and reviewed. No corrections are required.

4. Applicant's change to the title of the invention filed with respect to the objection of the title has been fully considered, and the objection is withdrawn. Applicant's changes to the Specification filed with respect to the acronym objections have been fully considered and the objection is withdrawn. The Examiners objection to the use of the word "tradeable" is withdrawn.

5. Applicant's changes filed with respect to the rejection of claims 1, 5 and 8 under 35 U.S.C. 112 have been fully considered. Applicant's amendments to the claims overcome the rejection. The Examiners objection to the term "trade on" is withdrawn.

6. Applicant's arguments filed with respect to the rejection of claims 1-14 under 35 U.S.C. 103(a), have been fully considered but are not persuasive. Therefore, claims 1-14 remain rejected as stated in the previous office action and Applicant's request for allowance is respectfully declined.

7. Specifically, Applicant's arguments filed with respect to:

"(a) transmitting responses to the requestor, as well as all traders who have responded to the RFP, and (b) allowing only the requestor and traders who have responded to the RFP to trade on the responses during an exclusive period"

has been fully considered but is not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features above, upon which applicant relies are not specifically recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claim language includes: "transmitting **one** or more responses to said requestor and **one** or more responders, each said trader not receiving said one or more responses unless said trader comprises a requestor or responder; allowing said

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requestor to trade on said **one** or more responses during a second period, each said trader not being allowed to trade on said one or more responses during said first period unless said trader comprises a requestor.” The Examiner is entitled to give the claim limitations their broadest reasonable interpretation in light of the Specification (see below):

Claim Interpretation; Broadest Reasonable Interpretation:

<CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification.” Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969).>

If the claim is read to be **one requestor and one responder with one transmitted response** (as is provided in the claim language), Luke discloses claimed invention (col. 5, line 14 – col. 6, line 55; col. 9, line 1 – col. 10, line 19). Under their broadest reasonable interpretation in light of the Specification, the claims are taught and no inventive concept is found. Applicant’s are respectfully requested to point out to the Examiner which claim limitations in the claims are considered to be the inventive concept because the inventive concept can not be determined from the claim limitations as written.

8. In reference to Applicant’s argument that Luke does not disclose: “providing an alert to each trader whose tradeable structure includes the RFP structure.” As provided

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in claim 1, a "trader" can be a requestor or a responder. Luke does disclose showing or presenting (effectively, alerting) to matches made in the system.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. **Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luke et al (US Patent No. 6,131,087, hereinafter Luke).** In reference to claims 1, 8, 12 and 14, Luke discloses a *method and system* of electronically trading financial instruments including:

- a. receiving a request for proposal ("RFP") on a financial instrument from a requestor, the RFP including an RFP structure (col. 4, lines 4-25);
- b. providing an alert to each trader whose tradable structures include the RFP structure (col. 4, lines 4-25; col. 5, lines 53-67);
- c. during a first response period, receiving at least one response to said RFP from at least one responder (col. 5, line 14 – col. 6, line 55; col. 9, line 1 – col. 10, line 19);
- d. transmitting said at least one response to said requestor and said at least one responder, each said plurality of traders not receiving said responses unless said trader comprises said requestor or said at least one responder (col. 5, line 14 – col. 6, line 55; col. 9, line 1 – col. 10, line 19);
- e. allowing said at least one requestor to trade on said responses during a second exclusivity period, each said plurality of traders not being allowed to trade on said response during said second exclusivity period unless each said trader comprises said requestor, said first response period and said second exclusivity period being allowed to overlap (col. 9, line 48 – col. 10, line 34); and

f. at the expiration of said second exclusivity period, allowing said at least one responder to trade on said responses during a third exclusivity period, said plurality of traders not being allowed to trade on said responses during said third exclusivity period unless each such trader comprises a requestor or said at least one responder (col. 6, lines 12-55; col. 9, line 1 – col. 10, line 34).

12. In reference to claim 2, Luke teaches the electronic trading method and system further comprising matching orders at the expiration of said first period and before allowing said responders to trade on said responses (col. 5, line 14 – col. 6, line 55; col. 9, line 1 – col. 10 line 34).

13. In reference to claim 3, Luke discloses the electronic trading method and system wherein said orders are associated with a bid price or an offer price, said matching orders process further comprising matching crossed orders in which the highest bid prices is higher than the lowest offer price (col. 6, line12 – col. 10, line 19).

14. In reference to claim 4, Luke discloses the electronic trading method and system wherein any responses, which have not been traded on at the end of, said second period are migrated to a general market (col. 6, line12 – col. 10, line 19, *Luke discloses various "market participants" which could include the general market as an entity and a participant.*).

15. In reference to claim 5, Luke discloses the electronic trading method and system wherein traders are grouped into trading groups, said method further comprising transmitting said at least one response to said requestor's trading group and said at least one responder's trading group, each said plurality of traders not receiving said responses unless said trader comprises a trader in said requestor's trading group or said at least one responder's trading group (col. 6, lines 35-66, col. 9, line 1 – col. 10, line 19; *Luke discloses sorting according to level of congruence.*).

16. In reference to claims 6-7, 9 and 11, Luke discloses the electronic trading system:

g. allowing trader's in said requestor's trading group to trade on said responses during said first period, each said plurality of traders not being allowed to trade on said response during said first period unless said trader comprises a trader in said requestor's trading group (col. 6, lines 35-66);

h. allowing traders in said responder's trading group to trade on said responses during said second period (col. 6, lines 35-66, col. 9, line 1 – col. 10, line 19);

i. wherein said tradable structures for each said trader are a function of potential traders to a trade (col. 6, lines 12-19);

j. migrating said responses to a general market at the expiration of said third exclusive period (*As described in the evaluation of claim 4 supra.*).

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17. In reference to claim 10, Luke discloses the electronic trading method and system wherein said first period and said second period are co- terminus (col. 6, lines 35-66, col. 9, line 1 – col. 10, line 19, *The number of trading periods to use is a business choice.*).

Conclusion

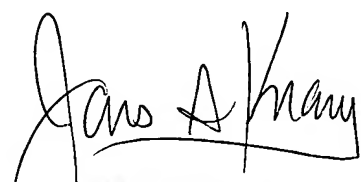
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached at (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
March 21, 2007

 3/21/07
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